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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,774	01/22/2004	Alan G. Ellman	PAT-133	3534

26267 7590 03/06/2006

JACK OISHER  
200 HIGH POINT DRIVE  
SUITE PH2  
HARTSDALE, NY 10530

EXAMINER

PEFFLEY, MICHAEL F

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/761,774	<b>Applicant(s)</b> ELLMAN ET AL.	
	<b>Examiner</b> Michael Peffley	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

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**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 7-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Thompson et al (6,830,569).

Thompson et al disclose an electrosurgical generator system that includes a console unit (20) having an RF power generating circuit therein (Figure 4). There are multiple connectors (40,42,44,46,48) for connecting multiple handpieces to the console so as to be operated in either a bipolar or monopolar mode. This device allows the surgeon access to multiple instruments and use of those instruments in the appropriate "sub-mode" (e.g. monopolar cutting and/or coagulating, bipolar coagulation, etc.). The console also includes separate controllers (32,34) for controlling the output of the generator in each sub-mode to provide a desired energy level in each mode of operation. One or more footswitches (38) are connected to a side of the console at another electrical connector. Once a given device is selected (e.g. bipolar coagulation device), that device may be controlled with the appropriate footswitch (or fingerswitch) and the operating voltage of the device may be individually controlled using the

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appropriate controller switches (32). The various microprocessor controls that enable the devices and their control is fully disclosed by Thompson et al.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garito et al (5,954,686) in view of the teaching of Ellman et al (5,562,503).

First, the instant invention has the same inventors as both the Garito et al and the Ellman et al references cited in this rejection.

Garito et al discloses the same basic system as set forth in the instant application. It includes a console (10) having inputs for connecting a bipolar device and a monopolar device. In particular, the device includes the same basic footswitches and fingerswitches for controlling the devices and also includes the same controls for independent controlling the energy output to each device. It is noted that this Garito et al reference is mentioned in, and incorporated by reference into, the instant specification. Applicant notes in the instant specification that the problem with the Garito et al system is that it provides two distinct operating frequencies, one for the bipolar device and one for the monopolar device. The present invention seeks to provide such a system with a single operating frequency in the range of 4 MHz.

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With regard to the operating frequency, the examiner notes that the Garito et al ('686) device is a further improvement of the Ellman et al ('503) system. The Ellman et al system provides an adaptor (10) that allows the connection of both a monopolar device and a bipolar device to an electrosurgical generator. The electrosurgical generator in this instance outputs a single operating frequency in the 4 MHz range (col. 3, line 42). Hence, the examiner maintains that it was generally known by the applicants that it was possible, and acceptable, to operate both a bipolar device and a monopolar device connected to the same generator and operating at the same operating frequency of about 4 MHz.

It is the examiner's position that the Garito et al system, which provides two distinct operating frequencies for a bipolar and a monopolar devices, could obviously have been operated with a single output frequency to both devices, particularly in view of the Ellman et al system that teaches providing a single output frequency to one of two devices connected to an RF generator.

Claims 4 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al ('569) in view of the teaching of Ellman et al ('503).

The Thompson et al reference has been previously addressed. While Thompson et al provide a single operating frequency from an RF generator that may be delivered to one of a bipolar or monopolar device connected to the system, there is no specific disclosure of the specific operating frequency being 4 MHz. Thompson et al simply do not disclose the specific operating frequency range of the system.

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Ellman et al, as addressed above, teach that it is generally known to provide electrosurgical generators with an operating frequency of about 4Mhz. Moreover, Ellman et al specifically teach that it is known to connect both a monopolar device and a bipolar device to such a generator to allow the user to have access to both devices in the same procedure.

To have provided the Thompson et al system with an operating frequency of 4 MHz would have been an obvious consideration for one of ordinary skill in the art, particularly since Ellman et al teach that it is known to use such a frequency in a system employing both a bipolar and a monopolar device.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al ('569) and Ellman et al ('503) as applied to the claims above, and further in view of Garito et al ('686).

Thompson et al and Ellman et al fail to disclose the particular arrangement of footswitches and fingerswitches as set forth in claims 5 and 6. Garito et al, as addressed previously, provide an analogous system including a bipolar and a monopolar device connected to an RF generator. Specifically Garito et al disclose the use of multiple footswitches and/or fingerswitches to activate the devices and control the delivery of energy to the appropriate device.

To have provided the Thompson et al system, as modified by the teaching of Ellman et al, with multiple footswitches for controlling the activation of the multiple

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devices would have been an obvious consideration for one of ordinary skill in the art in view of the teaching of Garito et al.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Perkins (4,071,028), Farin (4,171,700), Hooven et al (6,113,596) and Makower et al (5,613,966) all disclose various electrosurgical systems that include connections to operate both monopolar and bipolar instruments. Ellman et al (6,994,707) disclose another electrosurgical system substantially identical to the Garito et al ('686) system.

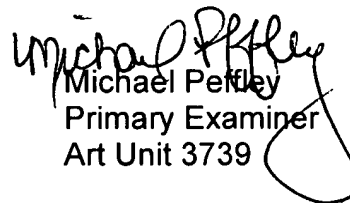
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michael Pfeiffer  
Primary Examiner  
Art Unit 3739

mp  
March 2, 2006

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